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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92050789
Party	Plaintiff Nartron Corporation
Correspondence Address	HOPE V SHOVEIN BROOKS KUSHMAN PC 1000 TOWN CENTER, 22ND FLOOR SOUTHFIELD, MI 48075 UNITED STATES rtuttle@brookskushman.com, hshovein@brookskushman.com
Submission	Brief on Merits for Plaintiff
Filer's Name	Hope V. Shovein
Filer's e-mail	hshovein@brookskushman.com, rtuttle@brookskushman.com, ejbrooks@brookskushman.com
Signature	/hope v shovein/
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UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD

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NARTRON CORPORATION

Petitioner,

v.

Cancellation No. 92050789

HEWLETT-PACKARD  
DEVELOPMENT COMPANY, L.P.,

Respondent.

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**PETITIONER'S MAIN BRIEF**

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## **I. DESCRIPTION OF THE RECORD**

The evidence of record consists of the pleadings and file of the involved registration, Registration No. 3,600,880. References to materials from the application file for Registration No. 3,600,880 are cited as: Reg. File, \_\_\_\_.

The following materials are also of record:

- The Testimony Deposition of John Washeleski, taken on September 2, 2010. Petitioner's Exhibits No. 1 – 30 and Respondent's Exhibit No. 100 were marked and offered in the testimony deposition of Mr. Washeleski. 37 CFR 2.123(e)(2) ("Exhibits which are marked and identified at the deposition will be deemed to have been offered into evidence, without any formal offer thereof, unless the intention of the party marking the exhibits is clearly expressed to the contrary"). Mr. Washeleski's testimony deposition is cited as: Washeleski Dep., p. \_\_, l. \_\_.
- Petitioner's September 23, 2010 Notice of Reliance. References to Petitioner's Notice of Reliance are cited as: Pet'r. Not. Reliance, \_\_\_\_.
- The Testimony Deposition of Ashley Frankart, taken on November 2, 2010. Exhibits No. 1 - 8 were marked and offered in the testimony deposition of Mr. Washeleski. 37 CFR 2.123(e)(2). Ms. Frankart's testimony deposition is cited as: Frankart Dep., p. \_\_, l. \_\_.
- The Testimony Deposition of Jean Terio Neumann, taken on November 16, 2010. Exhibits No. 1 - 13 were marked and offered in the testimony deposition of Ms. Neumann. 37 CFR 2.123(e)(2). Ms. Neumann's testimony deposition is cited as: Neumann Dep., p. \_\_, l. \_\_.
- Respondent's November 22, 2010 Notice of Reliance. References to Respondent's Notice of Reliance are cited as: Resp. Not. Reliance, \_\_\_\_.
- Petitioner's January 20, 2011 Rebuttal Notice of Reliance. References to Petitioner's Rebuttal Notice of Reliance are cited as: Pet'r. Rebut. Not. Reliance, \_\_\_\_.

## **II. STATEMENT OF THE ISSUE**

Does Respondent's mark TOUCHSMART so resemble the mark identified in Petitioner's pleaded registration, namely, SMART TOUCH, that confusion would be likely to result from HP's use of its mark in commerce in connection with the goods specified in its registration?

Petitioner answers: *Yes*.

### **III. INTRODUCTION AND RECITATION OF THE FACTS**

Nartron Corporation (“Nartron” or “Petitioner”) is the owner of U.S. Trademark Registration No. 1,681,891 for the SMART TOUCH trademark for “electronic proximity sensors and switching devices” in International Class 9. This registration issued April 7, 1992, and is incontestable, valid and subsisting, uncanceled and unrevoked.

Hewlett-Packard Development Company, L.P. (“HP” or “Respondent”) filed U.S. Trademark Application Serial No. 77/197,146 on June 7, 2007 for the mark TOUCHSMART for use and registration in connection with “personal computers, computer hardware, computer monitors, computer display screens” in International Class 9, claiming first use from January 29, 2007, and U.S. Registration No. 3,600,880 issued to HP for the same on April 7, 2009.

Nartron instituted this Section 2(d) (15 U.S.C. § 1052(d)) Petition to Cancel on April 9, 2009.

The similarity of the parties’ respective marks cannot be denied – they are formed of the same words, only re-ordered.

The similarity of the goods, as recited, in the respective registrations is indisputable - - the graphic user interface of HP’s TOUCHSMART “personal computers, computer hardware, computer monitors, computer display screens,” uses the “electronic proximity sensors and switching devices” of Nartron’s SMART TOUCH registration, U.S. Reg. No. 1,681,891.

The channels of trade are common, as will be proved by HP’s own publications, including its 2008 Form 10-K and promotional literature in the automotive industry.

The parties’ marks are similar. They sound the same. They look the same. They have similar connotations and create similar commercial impressions. They are likely to cause confusion.



## **A. Nartron Corporation**

Nartron is a designer and manufacturer of electronic systems and components that “sense, compute and control” for automotive and consumer product markets, and has generated numerous innovative patents. Washeleski Dep., p.6, l.18 and Ex. 11 (“Nartron Firsts”). Nartron is a pioneer in the technology field of capacitive sensing. An example is Nartron’s U.S. Patent No. 4,731,548, titled “Touch Control Switch Circuit,” which issued on March 15, 1988, based on an application filed on September 29, 1986 Washeleski Dep., Ex. 17.

### **1. SMART TOUCH**

Nartron first used its SMART TOUCH trademark in connection with proximity sensors and switching devices in 1986, and obtained a registration for the same in 1992. Pet’r. Not. Reliance, Ex. 1 (Petitioner’s U.S. Registration No. 1,681,891); also at Washeleski Dep., p.27, ll. 5-8 (Nartron has used the SMART TOUCH trademark in connection with electronic proximity sensors and switching devices continuously from 1986 through present). Nartron has successfully enforced its rights in SMART TOUCH, including via Trademark Trial and Appeal Board proceedings. Washeleski Dep. Ex. 22 (summary printout from TTAB Vue).

Nartron’s SMART TOUCH system “is a breakthrough in switching technology” featuring “either touch or proximity actuation.” Washeleski Dep., Ex. 14. When applied in a vehicle - - “Basically, it’s an iPhone for your car.” Washeleski Dep., Ex. 3. For example, the Chrysler 200C’s “iPhone-inspired” vehicle instrument panel “was developed by a team of eight engineers from Nartron (the company behind Apple’s Multiple Point Activation iPhone interface).” Washeleski Dep., p.12, l.24 – p.14, l.5, and Ex. 5. “Touch-screens like this one in Chrysler’s 200C EV Concept are the wave of the future”:



*Id.*; Pet'r. Not. Reliance, Ex. 3 (“Car Tech Trends for 2010 – and Beyond”). A published interview with Nartron’s founder, Norm Rautiola, further explains the benefits of this application of Nartron’s SMART TOUCH:

What a driver would normally see behind a steering wheel is a mish-mash of panels, buttons and gauges. The Smart Touch puts all that behind a thick, solid piece of plastic or glass without sacrificing user-friendliness. When the driver touches a display for the car’s windows, the windows go up or down.

... “It senses you when you wipe your finger or use multiple fingers. All buttons, knobs and levers are eliminated....”

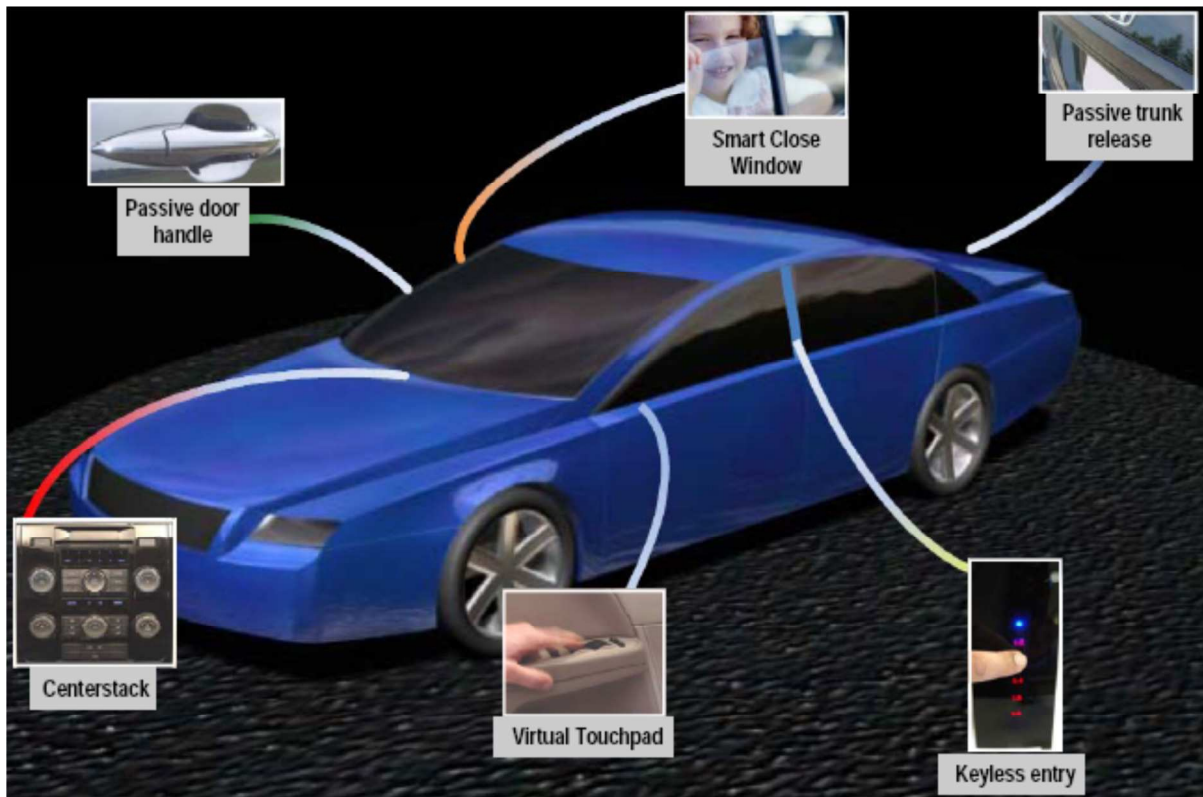
Pet'r. Not. Reliance, Ex. 2 (also Washeleski Dep., Ex. 3). A Nartron data sheet, titled “**Smart Touch®** Keypad Part No. 1310674,” further explains:

Smart Touch ® enables a person to use fingers to control computer software through a display screen. A key feature of Smart Touch ® allows multiple touches simultaneously or sliding fingers across a screen. Applications include the automobile IP [instrument panel], radio and HVAC controls.

Washeleski Dep., Ex. 16.

Nartron brochures also illustrate exemplary applications of Nartron’s SMART TOUCH products. For example, the “**Virtual Touchpad**” brochure shows application of Nartron’s SMART TOUCH products in an automotive window pad control. Washeleski Dep.,

Ex. 18. The “**Connecting you with your vehicle . . .**” brochure shows six different applications of SMART TOUCH technology in an automotive environment:



Washeleski Dep., Ex. 19.

Although the vehicle applications are perhaps most publicized, Nartron’s SMART TOUCH electronic proximity sensors and switching devices have a wide range of product applications, including:

Q. Does Nartron's Smart Touch technology have application in mobile handsets?

A. Yes.

Q. Does Nartron's Smart Touch technology have application in portable media players?

A. Yes.

Q. Does Nartron's Smart Touch technology have application in white goods, such as major appliances?

A. Yes.

Q. Does Nartron's Smart Touch technology have application in computers?

A. Yes.

Q. Does Nartron's Smart Touch technology have application in printers?

A. Yes.

Q. Does Nartron's Smart Touch technology have application in automotive products?

A. Yes.

Washeski Dep, p.32, l.17 – p.33, l.9.

## **B. Hewlett-Packard Development Company, L.P.**

HP is “a technology solutions provider to consumers, businesses and institutions globally.” Neumann Dep., Ex. 2, p.3. HP described its customers in its 2008 Form 10-K filed with the Securities and Exchange Commission:

Our customers are organized by consumer and commercial customer groups, and distribution is organized by direct and channel. Within the channel, we have various types of partners that we utilize for various customer groups. The partners include:

- retailers that sell our products to the public through their own physical or Internet stores;
- resellers that sell our products and services, frequently with their own value-added products or services, to targeted customer groups;
- distribution partners that supply our solutions to smaller resellers with which we do not have direct relationships;
- independent distributors that sell our products into geographies or customer segments in which we have little or no presence;
- original equipment manufacturers ("OEMs") that integrate our products with their own hardware or software and sell the integrated products;
- independent software vendors ("ISVs") that provide their clients with specialized software products, frequently driving sales of additional non-HP products and services, and often assist us in selling our products and services to clients purchasing their products; and

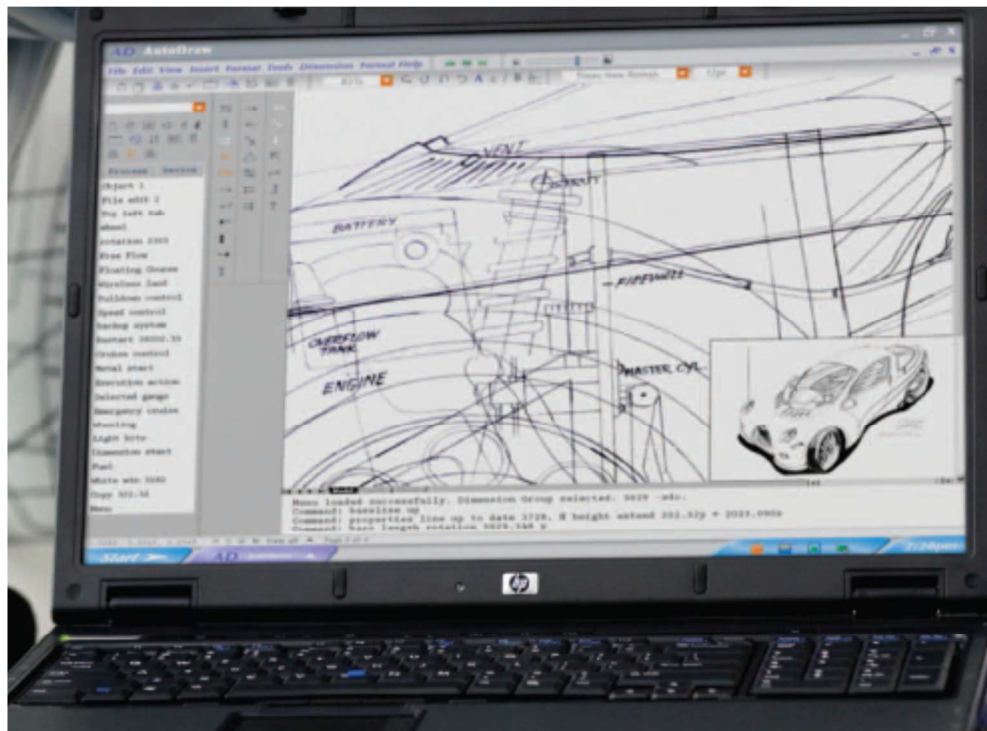
- systems integrators that provide various levels and kinds of expertise in designing and implementing custom IT solutions and often partner with HPS [HP Services] to extend their expertise or influence the sale of our products and services.

Pet'r. Not. Reliance, Ex. 12 (also Washeleski Dep., Ex. 21).

HP also has a substantial product presence in the automotive industry. This is proved by the HP brochure titled “**Improving automotive industry outcomes**”:



Pet'r. Not. Reliance, Ex. 11 (also Washeleski Dep., Ex. 20). An HP computer is shown in the photograph on page 4 of the HP brochure, under the heading “Product development”:



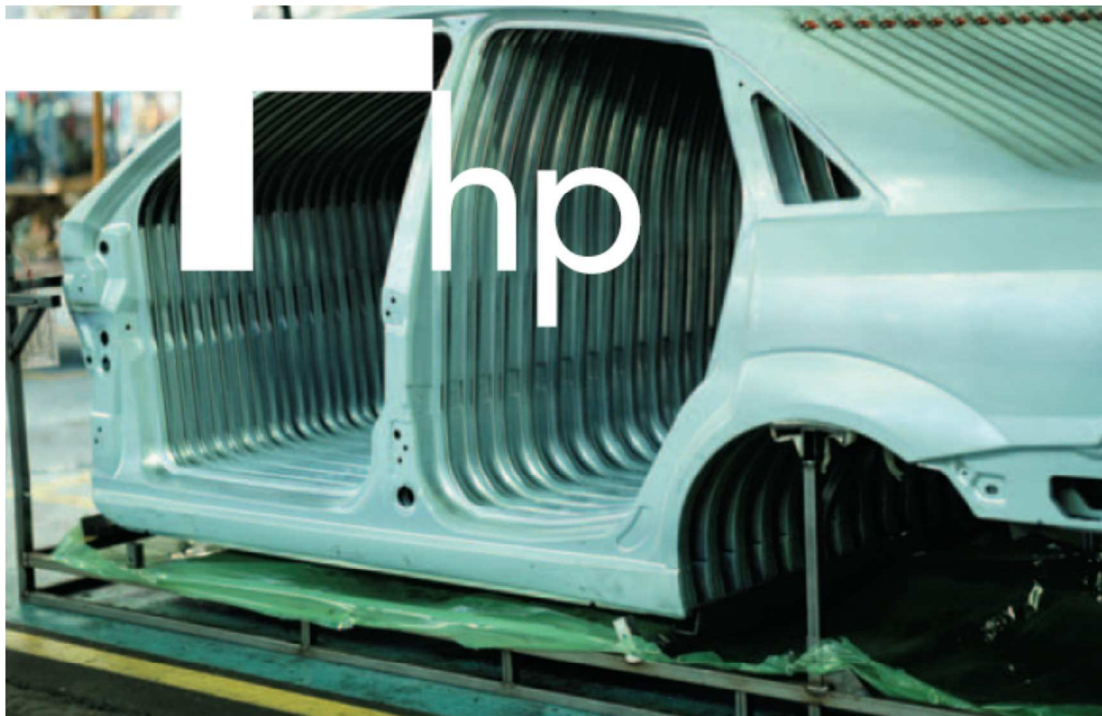
*Id* at p.4 (“By helping automotive manufacturers arrive at a ‘single version of the truth,’ HP Master Data Management solutions enable faster, more informed decision-making across the extended automotive enterprise”). The HP brochure further explains that HP is deeply invested in the automotive market, as typified by the following excerpt from page 6:

**High-performance computing for the automotive industry**

HP provides a portfolio of high-performance computing solutions that help design teams improve productivity, collaboration and design validation capabilities.

*Id* at p.6.

HP’s presence in the automotive industry is further proved by the HP brochure titled “**HP solutions for the automotive industry**”:



HP solutions for the  
automotive industry  
Greater agility for the road ahead



Pet'r. Not. Reliance, Ex. 10 (also Washeleski Dep., Ex. 28). In this brochure, HP advertises that it "serves most of the major automotive OEMs and suppliers and has been working with them for more than 30 years." *Id* at p.5.

In addition, HP's recent contract with General Motors received some press, further evidencing HP's presence in the automotive industry. *See* Pet'r. Not. Reliance, Ex. 7 ("GM gives \$2B contract to Hewlett Packard") (also Washeleski Dep., Ex. 23); Pet'r. Not. Reliance, Ex. 8 ("General Motors Renews \$2 Billion HP Enterprise Services Agreement Supporting Vehicle Design and Production") (also Washeleski Dep., Ex. 24); and Pet'r. Not. Reliance, Ex. 9 ("HP in the Motor City") (also Washeleski Ex. 25).

Finally, HP has also sold notebook and tablet computers designed for in-vehicle use: "Both the HP Rugged Notebook and HP Rugged Tablet PC are intended for the most demanding environments and such undergo... four additional tests: 2 Vehicle Vibrations tests, the Vehicle Shock test, and the Vehicle Crash test." Neumann Dep., Ex. 14, p.3. HP could not confirm that it would never market such products under the TOUCHSMART brand. Neumann Dep., p.64, l.12 ("...anything is possible").

## **1. TOUCHSMART**

HP conducted an "internal search" to clear TOUCHSMART on or before August 4, 2006. Pet'r. Not. Reliance, Ex. 16 (Respondent's July 8, 2010 Privilege Log). HP announced the TOUCHSMART PC, "the industry's first all-in-one touch-screen PC," on January 7, 2007, at the 2007 International Consumer Electronics Show, and subsequently filed an application for TOUCHSMART on June 7, 2007 for "personal computers, computer hardware, computer monitors, computer display screens," claiming first use from January 29, 2007. Neumann Dep., Ex. 2.



HP advertises its TOUCHSMART products as “designed to fit wherever life happens.” Neumann Dep., Ex. 4. HP describes “The TouchSmart advantage” as follows: “Use your fingers for fast access to information, communication tools, and entertainment. The intuitive touch technology makes everything you do easier and more fun.” Frankart Dep., Ex. 7, p.2.

HP’s products sold under TOUCHSMART include the “TouchSmart tm2t” touchpad PCs, an all-in-one tablet PC, where the touchpad “acts as a mouse and a keyboard.” Neumann Dep., p.14, ll. 13-17. In addition, the TOUCHSMART tx2 notebook PC is designed for “those whose active lives demand a device for... robust computing that’s easy to carry,” “... in an attractive design light enough to go anywhere.” Frankart Dep., Ex. 8, p.2. HP confirmed that the TouchSmart tm2 could fit in a vehicle. Frankart Dep, p.35, ll. 23-25 (“I think a lot of people use their notebooks in the back seat or passenger seat of a car...”).



#### **IV. ARGUMENT**

At the outset, Petitioner has standing to seek cancellation of the TOUCHSMART registration. Petitioner has (1) a “real interest” in the proceedings; and (2) a reasonable basis for the belief that Petitioner will suffer damage if continued registration of the TOUCHSMART mark is allowed. *Ritchie v. Simpson*, 50 U.S.P.Q.2d 1023, 1025-26 (Fed. Cir. 1999).

Petitioner made their SMART TOUCH registration of record and Petitioner has clear priority – Petitioner’s incontestable SMART TOUCH registration is conclusive evidence of the validity of the registered mark, of the registration of the mark, of the owner's ownership of the mark and of the owner's exclusive right to use the mark with the goods/services. 15 U.S.C. § 1115(b). Respondent did not offer any evidence to rebut these presumptions or challenge Petitioner’s priority. Therefore, priority is not an issue in this proceeding.

The similarity of the marks and the goods support a reasonable basis for Petitioner’s claims of likelihood of confusion.

##### **A. Section 2(d) Legal Standards**

The likelihood of confusion determination is a question of law, based on underlying factual determinations. *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1326, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). The factors to be considered by the Board *en route* to determining whether a likelihood of confusion exists are those set forth in *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). The *DuPont* factors are:

- (1) the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression;
- (2) the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use;

- (3) the similarity or dissimilarity of established, likely-to-continue trade channels;
- (4) the conditions under which and buyers to whom sales are made, i.e., “impulse” vs. careful, sophisticated purchasing;
- (5) the fame of the prior mark (sales, advertising, length of use);
- (6) the number and nature of similar marks in use on similar goods;
- (7) the nature and extent of any actual confusion;
- (8) the length of time during and conditions under which there has been concurrent use without evidence of actual confusion;
- (9) the variety of goods on which a mark is or is not used (house mark, “family” mark, product mark);
- (10) the market interface between applicant and the owner of a prior mark;
- (11) the extent to which applicant has a right to exclude others from use of its mark on its goods;
- (12) the extent of potential confusion (de minimis or substantial); and
- (13) any other established fact probative of the effect of use.

*Recot*, 214 F.3d at 1326, 54 USPQ2d at 1896.

It is well-established that a single *DuPont* factor may be dispositive in a likelihood of confusion analysis. The following *DuPont* analysis focuses on the most significant factors in this proceeding, including the similarity of the marks, goods, and trade channels.

## **B. Analysis Of The Relevant *DuPont* Factors**

### **1. Similarity Of The Marks**

*DuPont* factor 1 is: “The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” The Federal Circuit stated that the first *DuPont* factor “is a predominant inquiry.” *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002).

The parties' relevant marks are reproduced below:

**SMART TOUCH**

**TOUCHSMART**

It is self-evident that these marks are formed of the same words, i.e., SMART and TOUCH, with their order reversed in each mark.

It is a venerable rule of registration practice that "the points of similarity are of greater importance than the points of difference." *Hoffman-LaRoche, Inc. v. Kawerk*, 148 F.2d 557, 65 U.S.P.Q. 218, 220 (C.C.P.A. 1945). An important point of similarity of SMART TOUCH and TOUCHSMART is that they are formed of identical words.

The only point of difference is the ordering of the words SMART and TOUCH. However, transposing words does not make the resultant marks dissimilar. The Board's Opinion in *Bank of America National Trust and Savings Assoc. v. The American National Bank of St. Joseph*, 201 U.S.P.Q. 842 (TTAB 1978), is informative to the present case. In *Bank of America*, the rival word marks were BANKAMERICA and BANK OF AMERICA, on one hand, and AMERIBANC, on the other hand. The Board found these marks "similar," as explained in the following excerpt from the *Bank of America* Opinion:

In the present case, the words "BANKAMERICA" and "BANK OF AMERICA," on one hand, and "AMERIBANC," on the other, convey the same meaning and create substantially similar commercial impressions. In view thereof, and considering that this is not a case where the marks of the parties are likely to be encountered by purchasers on a side-by-side basis, and that the average purchaser is not infallible in his recollection of trade designations and may well transpose the elements of a mark in his mind, we do not believe that differences between the marks of the opposer and applicant, considered in their entirety, are sufficient to preclude the likelihood that the contemporaneous use of these marks in connection with similar services here involved will result in confusion or mistake or deception.

*Bank of America*, 201 U.S.P.Q. at 845.

HP's transposition of the word elements of the mark SMART TOUCH to form TOUCHSMART does not make the marks dissimilar.

Indeed, HP agrees that the parties' marks are similar:

Q. Now we went through the scenario that if Nartron did make a product competitive with the present day TouchSmart products of HP and branded that product Smart Touch, why would you find that objectionable?

A. Because if they were the same type of product, both PCs, both touch screen, both all-in-one **and the names were that close, that could be confusing.**

Frankart Dep., p.34, ll.19-25.

Q. You'd have no objection to Nartron introducing a brand of personal computers under the name – under the brand SmartTouch to compete with HP's TouchSmart?

...

A. Yes, I would.

Q. Why would you object to that?

A. They would be identical products.

Neumann Dep., p.56, ll.5-13.

The parties' marks are not only similar in sound and appearance (as they are formed by the same 2 words). The parties' marks also have the same or similar connotation and create the same or similar commercial impression – both parties' relevant products are controlled by touch.

The similarity of the rival SMART TOUCH and TOUCHSMART marks cannot be denied.

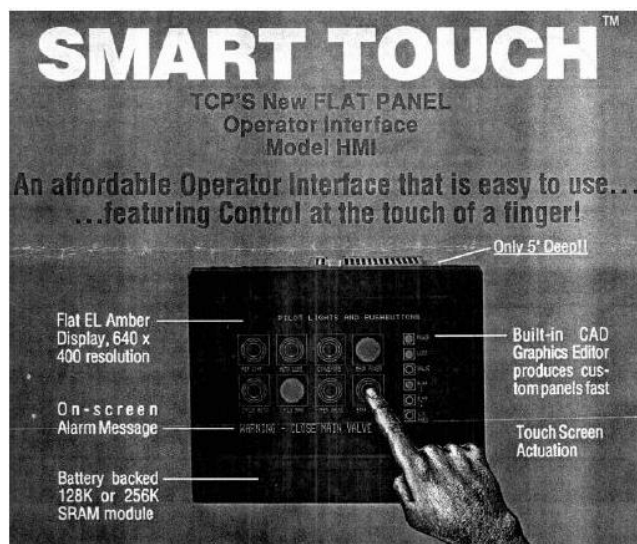
## 2. Similarity Of The Goods

*DuPont* Factor No. 2 is the “similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.” *In re E.I. DuPont DeNemours*, 476 F.2d at 1361. Even if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services. It is sufficient that the respective goods or services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods or services are such that they could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. *See Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

The goods of Nartron’s ‘891 registration are: “electronic proximity sensors and switching devices.”

The goods of HP’s ‘880 registration are: “personal computers, computer hardware, computer monitors, computer display screens.”

The graphic user interface of HP’s TOUCHSMART “personal computers, computer hardware, computer monitors, computer display screens,” uses the “electronic proximity sensors and switching devices” of Nartron’s ‘891 registration. This is illustrated by a side-by-side comparison the specimens of use in the application files of Nartron’s ‘891 registration and HP’s ‘880 registration, reproduced below.



HP TouchSmart / Main



HP's TOUCHSMART "personal computers, computer hardware, computer monitors, computer display screens," use embedded capacitors that sense the proximity of a user's finger on the screen to alter electrical circuit properties that implement various system control functions (e.g., switching). This is explained in the press release from Cypress Semiconductor Corporation, dated May 9, 2007, titled: "Cypress's PSoC® CapSense Enables Touch Sensing Inside HP Compaq Notebook PCs." Pet'r. Not. Reliance, Ex. 5 (also Washeleski Dep., Ex. 15). The following sentence from the Cypress press release explains:

With Cypress's CapSense interface, a finger on the interface forms an electrical connection with embedded sensors, which work with the PSoC device to translate data about the finger's presence into various system control functions.

These embedded sensors (capacitors) and their associated circuits *are* the "electronic proximity sensors and switching devices" of Nartron's '891 registration.

Furthermore, the HP brochures specific to the automotive industry are in direct conflict with HP's position that its goods are primarily consumer goods. The word "consumer" does not appear in the recitation of goods in HP's '880 registration. HP's TOUCHSMART "personal computers, computer hardware, computer monitors, computer display screens," are not

limited to any product field or application, or class of customers. Indeed, HP is aggressively pursuing the automotive market. HP's TOUCHSMART products and Nartron's SMART TOUCH products are positioned to intersect in common product markets and among common customers.

Accordingly, the respective goods of Nartron's '891 registration and HP's '880 registration are "related," in the sense of *DuPont* Factor No. 2.

### **3. Similarity Of The Trade Channels**

*DuPont* Factor No. 3 is the "similarity or dissimilarity of established, likely-to-be continued trade channels." *In re E.I. DuPont DeNemours*, 476 F.2d at 1361.

As notes above, HP's '880 registration has no limitation on channels of trade ("personal computers, computer hardware, computer monitors, computer display screens"). The Board should assume that these goods are sold in all normal channels. "It is well settled that in a proceeding such as this, the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in an opposer's registration, rather than what the evidence shows the goods and/or services to be." *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). *See, also, Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed").

Not only is the subject registration not limited to certain trade channels, but the evidence shows that HP's customers are in multiple trade channels – overlapping with Nartron's trade channels. This includes the automotive industry. HP's testimony confirms the overlap:

Q. ...Would automotive companies be considered potential customers?

A. I think HP likes to think everyone's a potential customer.

Frankart Dep., p.33, ll.20-23.

HP's 2008 Form 10-K and brochures for the automotive industry – discussed in detail earlier in this brief – further prove the overlap in the parties' trade channels.

It is clear that Nartron and HP sell their respective goods through the same channels of trade to the same classes of customers. The record evidence on *DuPont* Factor No. 3 is in favor of Nartron.

#### **4. HP's Intent In Selecting The TOUCHSMART Mark**

*DuPont* Factor No. 13 is: "Any other established fact probative of the effect of use." The final factor is the catch-all that considers intent and good faith.

Nartron served admission requests regarding whether HP knew of Nartron's rights in SMART TOUCH prior to HP's adoption of the TOUCHSMART mark. For instance, if Nartron's '891 registration appeared on a search report conducted by or on behalf of HP (which is discoverable), it would be probative of HP's intent in selecting and adopting a mark that differs only by transposition of the word elements.

Nartron's Request for Admission No. 2 asked HP to "[a]dmit that Respondent became aware of Petitioner's SMART TOUCH trademark identified in Registration No. 1,681,891 prior to filing Application No. 77/197,146 for TOUCHSMART, which matured into Registration No. 3,600,880." Subject to its objections, HP denied this request, also stating that



“Respondent is not aware of any non-attorney or non-paralegal knowledge by Respondent of Petitioner’s mark prior to the filing of Application No. 77/197/146 [*sic*] for TOUCHSMART.” Pet’r. Not. Reliance, Ex. 17 (Respondent’s July 8, 2010 Responses to Petitioner’s First Set of Requests for Admission).

Nartron’s Request for Admission No. 3 asked HP to “[a]dmit that a trademark search was conducted by or on behalf of Respondent for TOUCHSMART prior to filing Application No. 77/197,146 for TOUCHSMART, which matured into Registration No. 3,600,880.” Subject to its objections, and “to the extent ‘trademark search’ is defined as a search performed by a third party” (although the request specifically stated “by or on behalf of”), HP denied this request. Pet’r. Not. Reliance, Ex. 17 (Respondent’s July 8, 2010 Responses to Petitioner’s First Set of Requests for Admission).

Confusingly, on the same day that HP served its responses to the above-mentioned admission requests, HP also provided its privilege log regarding an “internal search” and related correspondence. Pet’r. Not. Reliance, Ex. 16 (Respondent’s July 8, 2010 letter to Petitioner’s counsel regarding discovery responses and document production, including Respondent’s July 8, 2010 Privilege Log). All of the materials identified on the privilege log - - all relating to the initial “internal search” for TOUCHSMART in August of 2006 - - are designated as “work product”, although the search was conducted approximately 9 and ½ months before HP filed its TOUCHSMART application. Therefore, HP apparently claims that even its initial search was conducted in anticipation of eventual litigation over use of TOUCHSMART, indicating that it was well aware of the possibility for confusion.

HP’s obvious concealment of any relevant search reports tips the “intent” factor in Nartron’s favor.

**5. Nartron Has Vigorously Defended Its SMART TOUCH Registration Before The Board**

Nartron has brought numerous proceedings before the Trademark Trial and Appeal Board over the past many years in respect of its SMART TOUCH mark of U.S. Reg. No. 1,681,981, and resolved them all satisfactorily to Nartron. This is evidenced by the summary printout from TTAB Vue. Washeleski Dep. Ex. 22.<sup>1</sup> Such evidence of Nartron's aggressive trademark enforcement activities reinforce the strength of its mark. See *J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition*, § 11.91 (4th ed. 2005) ("... active program of prosecution of infringers ... enhances the distinctiveness and strength of a mark").

Nartron's record of aggressive enforcement supports a conclusion on this record that Nartron's mark is distinctive and entitled to a relatively broad scope of protection.

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<sup>1</sup> The most recent being *Narton Corporation v. HID Global Corporation*, Opposition No. 91191565. The settlement is too recent to be of record, but the Board may take judicial notice of the withdrawn applications by HID for SMARTTOUCH and SMARTTOUCH XTREME for "smart card readers" in International Class 9, which were the subject of the opposition.

## V. CONCLUSION

[I]f there be any doubt on the issue of likelihood of confusion, the familiar rule in trademark cases ... is that it must be resolved against the newcomer or in favor of the prior user or registrant.

*In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes*, 487 F.2d 918, 919-920, 179 USPQ 729 (CCPA 1973).

SMART TOUCH has been (i) a flagship trademark of Nartron for over 20 years, (ii) registered on the Principal Register for over 18 years, and (iii) successfully asserted in more than ten (10) prior proceedings before the Board.

Nartron's registration issued approximately fifteen (15) years prior to the filing of HP's application and alleged date of first use. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974) (priority is not an issue in an opposition where the opposer makes of record its valid and subsisting registrations).

HP is the newcomer. A party entering a field of business has a plethora of possible marks available to him. "A newcomer has both the opportunity and the obligation to avoid confusion." *Carl Karcher Enterprises, Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125, 1133 (TTAB 1995). There is no justification for HP's selection of a mark likely to cause confusion.

The evidence before the Board on the relevant *DuPont* factors demonstrates that a likelihood of confusion exists. Accordingly, Nartron respectfully requests that the Board grant the Petition to Cancel.

Respectfully submitted,

**BROOKS KUSHMAN P.C.**

By: Hope Shovein

Robert C.J. Tuttle  
Hope V. Shovein  
1000 Town Center  
Twenty-Second Floor  
Southfield, Michigan 48075

*Attorneys for Petitioner*

Dated: March 21, 2011

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of **PETITIONER'S MAIN BRIEF** has been served on March 21, 2011 by:

\_\_\_ delivering

√ mailing (via First-Class mail)

a copy to:

Diana D. Digennaro  
HOWARD, RICE, NEMEROVSKI,  
CANADY, FALK & RABKIN  
Three Embarcadero Center  
Seventh Floor  
San Francisco, CA 94111

*Attorney for Respondent*



\_\_\_\_\_  
Hope V. Shovein

**CERTIFICATE OF TRANSMISSION**

I hereby certify that **PETITIONER'S MAIN BRIEF** was filed on the same day with the Trademark Trial and Appeal Board by electronically filing through the Electronic System for the Trademark Trial and Appeals at <http://estta.uspto.gov>.

On this 21<sup>st</sup> day of March, 2011.



\_\_\_\_\_  
Hope V. Shovein